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09/776,362	02/02/2001	Donald W. Taylor	DE007DT-1	1840

7590 03/19/2002

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[REDACTED] EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
1711	4

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

A 9 - 4

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

#### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-20 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

#### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 83  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-20 are under examination.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 11, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is vague because it is not clear if bitumen (not bitumin as recited in this claim) and passivating agent are members of Markush group or not. Furthermore “ethylene acrylics” is vague. Proper term may be “ethylene acrylic copolymers”.

Claim 11 is indefinite in reciting “ethyl vinyl acetate”.

Correct word should be “ethylene vinyl acetate”.

Claims 19 and 20 provide for the use of a composition, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for withdrawal Sep 05, 2002

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example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54033542.

(JP '542 is of record on PTO- 1449, paper no. 2)

*(moot, 1&19 are cancelled  
Jan 22, 2005)*

JP '542 disclose antitrust compositions containing petroleum or grease and additives such as gilsonite, polyolefins etc. Polyolefins include polyisobutylene. Inert siliceous fillers may be added. Also suitable are other resins viz. polypropylene, polybutene and polyesters. Composition *W/W* is useful for preventing corrosion of steam pipes.

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Therefore it would have been obvious to follow teachings of JP '542 and arrive at instant invention.

5. Claims 5, 9, 12 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54033542 as applied to claim 1 above, and further in view of Heimann et al (USP 6017857), and Nee (USP 4983449).

JP '542 does not mention silicate (as a filler) (instant claim 12\_).

*most  
clms are  
cancelled  
Jan 23, 2003*

Heimann discloses corrosion resistant lubricants, greases and gels. The grease includes silica/silicate mixture (abstract; col. 3, line 62 to col. 4 line 7). Calcium silicate is a suitable ~~silicate~~ silicate (col. 6, lines 37-38). Patentee also discloses use of other additives such as polyethylene, polyvinylidene difluoride, polytetrafluoroethylene, polyvinyl chloride in col 26, lines 15-19 which are considered as reinforcements.

Therefore it would have been obvious to use calcium silicate and other additives of Heimann in the composition of JP' 552 in order to increase pH and thereby enhance corrosion resistance.

Nee discloses protective wrapping material. The wrapping material is bonded to a substantially non-elastic porous support backing formed of thermoplastic material like polypropylene (col 4, lines 24-37).

Therefore it would have also been obvious to use a support backing or reinforcement for the composition of JP '542 in order to make it easy for storage, handling and use.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 54033542. *most  
01/23/2003*

Disclosure of JP '542, presented earlier, shows that claim 1 lacks novelty.

8. Claims 2-4, 6-8, 10, 11, 13-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54033542 in view of Lyons Jr. (USP 5263287), Heimann (USP 6017857), Nee (USP 4983449), Pachl et al (USP 6174932) and Glorieux (USP 5399189). *withdrawn  
01/23/2003*

Disclosures of JP '542, Heimann and Nee are presented earlier.

JP '542 does not mention bitumen and EPDM (of instant claim 4).

Lyons discloses roofing membrane flashing. The flashing is made from a corrosion resistant material, for example EPDM coated aluminum (abstract; col 6 lines 21-27; col 7 lines 45 and 51).

Pachl discloses curable sealant composition comprising an epoxy, a polyol, a thickener, a ~~photoinitiator~~ photoinitiator and a monomer (col 18 lines 22-26). Patentee in col. 9 lines 17-38, teaches the use of expansion agents.

Glorieux discloses anticorrosive protective composition for metals. According to patentee, use of polymer micro parts (such as Expance) considerably improves corrosion resistance (col 2 lines 21-31).

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Therefore it would have been obvious to use (a) EPDM terpolymer as the binder in the composition of JP '542 to enhance antirust properties, (b) a thermosetting compound like an epoxy resin together with a curing agent like photo initiator (taught by Pachl) to enhance durability, adhesion to substrate, together with resistance to mold growth and dimensional changes while reducing solvent emissions and © expansion agent/s (taught by Pachl and *UKR* Glorieux) so that the composition swells on curing and thereby reaches and adheres to substrate which is not planar, resulting in improved corrosion resistance.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday-Friday from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310/9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*UKR*  
UKRajguru:evh

3/11/02

*Jamie L. Seidleck*  
JAMES J. SEIDLECK  
Examiner  
Patent Office  
3/11/02